

REMARKS**35 U.S.C. §112**

The Office Action rejected claim 49. To facilitate prosecution of this application, claim 49 has been canceled without prejudice.

35 U.S.C. §102

MPEP 2131 quotes Verdegaal Brothers v. Union Oil of California, 814 F.2d 628, 631 (Fed. Cir. 1987) for the legal standard of anticipation: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (emphasis added).

Claims 60, 64-71

Amended claim 60 claims, among other elements, an anastomosis system comprising "a handle connected to at least one of said first member and said second member, said handle including an element having at least one cam slot defined therein; wherein said first member and said second member each engage at least one said cam slot." The cam slots are disclosed in the specification at, for example, page 16, lines 20-27, and Figures 19-22.

In contrast, U.S. Pat. No. 5,403,333 to Kaster ("Kaster") does not disclose each and every element of amended claim 60. For example, Kaster does not disclose a "handle including an element having at least one cam slot defined therein," much less a system "wherein said first member and said second member each engage at least one said cam slot."

Thus, Kaster does not disclose each and every element claimed in claim 60, and Applicants consequently believe claim 60 is in condition for allowance. Dependent claims 64-71 are believed to be in condition for allowance as well under MPEP 608.01(n)(III).

Claims 72, 76-84

Amended claim 72 claims, among other elements, a "handle including an element having at least one cam slot defined therein; wherein said first member and said second member each engage at least one said cam slot."

In contrast, Kaster does not disclose each and every element of amended claim 72. For example, Kaster does not disclose a "handle including an element having at least one cam slot defined therein," much less a system "wherein said first member and said second member each engage at least one said cam slot."

Thus, Kaster does not disclose each and every element claimed in claim 72, and Applicants consequently believe claim 60 is in condition for allowance. Dependent claims 76-84 are believed to be in condition for allowance as well under MPEP 608.01(n)(III).

35 U.S.C. §103

MPEP 706.02(j) states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q. 1438 (Fed. Cir. 1991) (emphasis added).

Claims 38, 41-48, 53-59

Claim 38 has been amended to include the limitations of claim 50, which has been canceled. Claim 50 had been objected to as being dependent upon a rejected base claim, and

the Examiner stated that it would be allowable by rewriting it in independent form. Because claim 50 has been incorporated into independent claim 38, Applicants believe independent claim 38 is in condition for allowance. Because claims 41-48 and 53-59 depend from claim 38, Applicants believe that they are in condition for allowance as well under MPEP 608.01(n)(III).

Applicants note that the Office Action states that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the anastomosis device unitary...to stabilize the anastomosis device and graft vessel." The term "stabilize" does not appear in claim 38 or in any claim that depends from it, and is not a limitation of any of the pending claims.

REQUEST FOR ALLOWANCE

Allowance of the pending claims are respectfully solicited. Please contact the undersigned if there are any questions.

Respectfully submitted,



Brian A. Schar
Attorney for Applicants
Reg. No. 45,076
Tel. No. (650) 331-7162
Chief Patent Counsel
Cardica, Inc.